



UNITED STATES PATENT AND TRADEMARK OFFICE

7
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,414	12/20/2001	Kent A. Franklin	KCC 4785 (KC# 16,648B)	3743

321 7590 03/23/2004
SENNIGER POWERS LEAVITT AND ROEDEL
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS, MO 63102

EXAMINER	
FISCHER, JUSTIN R	
ART UNIT	PAPER NUMBER
1733	

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,414

Applicant(s)

FRANKLIN ET AL

Examiner

Justin R Fischer

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, drawn to an apparatus for guiding an elongate member having a guide assembly comprising a positioning arm and a guide adapted for pivoting about said positioning arm, classified in class 156, subclass 379.8.
 - II. Claims 10-15 and 22-28, drawn to an apparatus for guiding a pair of elongate members having a pair of guides, classified in class 156, subclass 379.8.
 - III. Claims 16-21, drawn to an apparatus for guiding an elongate member comprising a base and a guide assembly including a guide, classified in class 156, subclass 379.8.
 - IV. Claims 29 and 30, drawn to a method of applying an elongate member to a substrate, classified in class 156, subclass 160.
 - V. Claim 31-34, drawn to an apparatus for guiding an elongate member onto a substrate, classified in class 156, subclass 379.8.
2. Inventions I and II are related as independent inventions, each having a unique and separate means for establishing patentability. Invention I is directed to an apparatus for guiding a single elongate member onto a substrate having a positioning arm and a guide, whereas Invention II is directed to an apparatus for guiding multiple elongate members onto a substrate having multiple guides. In this instance, Invention I

Art Unit: 1733

does not require multiple guides and Invention II does not require a guide assembly having a positioning arm. As such, the inventions contain patentably distinct subject matter and restriction is proper.

3. Inventions I and III are related as independent inventions, each having a unique and separate means for establishing patentability. Invention I is directed to an apparatus for guiding a single elongate member onto a substrate having a positioning arm and a guide, whereas Invention III is directed to an apparatus for guiding a single elongate member onto a substrate having a base and a guide assembly, including a guide, that is pivotally connected to said base. In this instance, Invention I does not require a base and thus necessarily fails to require that the guide assembly is pivotally connected to said base and Invention III does not require a guide assembly having a positioning arm. As such, the inventions contain patentably distinct subject matter and restriction is proper.

5. Inventions I and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process, such as one in which the guide is not moved relative to the guide assembly (if no variation in position of the elongate member is desired).

6. Inventions I and V are related as independent inventions, each having a unique and separate means for establishing patentability. Invention I is directed to an

Art Unit: 1733

apparatus for guiding a single elongate member onto a substrate having a positioning arm and a guide, whereas Invention VI is directed to an apparatus for guiding an elongate member onto a substrate having a guide assembly including a guide that is supported on said guide assembly through an arc of 360 degrees. In this instance, Invention I does not require the guide be supported on a guide assembly over a 360 degree arc and Invention VI does not require a positioning arm. As such, the inventions contain patentably distinct subject matter and restriction is proper.

7. Inventions II and III are related as independent inventions, each having a unique and separate means for establishing patentability. Invention II is directed to an apparatus for guiding multiple elongate members onto a substrate having multiple guides, whereas Invention III is directed to an apparatus for guiding a single elongate member onto a substrate having a base and a guide assembly including a guide. In this instance, Invention II does not require a base and Invention II does not require multiple guides. As such, the inventions contain patentably distinct subject matter and restriction is proper.

8. Inventions II and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process, such as one in which the guide is not moved relative to the guide assembly (if no variation in position of the elongate member is desired).

Art Unit: 1733

9. Inventions II and V are related as independent inventions, each having a unique and separate means for establishing patentability. Invention II is directed to an apparatus for guiding multiple elongate members onto a substrate having multiple guides, whereas Invention V is directed to an apparatus for guiding an elongate member onto a substrate having a guide assembly including a guide that is supported on said guide assembly through an arc of 360 degrees. In this instance, Invention II does not require the guide be supported on a guide assembly over a 360 degree arc and Invention V does not require an apparatus having multiple guides. As such, the inventions contain patentably distinct subject matter and restriction is proper.

10. Inventions III and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process, such as one in which the guide is not moved relative to the guide assembly (if no variation in position of the elongate member is desired).

11. Inventions III and V are related as independent inventions, each having a unique and separate means for establishing patentability. Invention III is directed to an apparatus for guiding a single elongate member onto a substrate having a base and a guide assembly, including a guide, that is pivotally connected to said base, whereas Invention V is directed to an apparatus for guiding an elongate member onto a substrate having a guide assembly including a guide that is supported on said guide assembly

Art Unit: 1733

through an arc of 360 degrees. In this instance, Invention III does not require the guide be supported on a guide assembly over a 360 degree arc and Invention V does not require an apparatus having a base and a guide assembly, including a guide, that is pivotally connected to said base. As such, the inventions contain patentably distinct subject matter and restriction is proper.

12. Inventions IV and V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process, such as one in which the guide is not moved relative to the guide assembly (if no variation in position of the elongate member is desired).

13. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

14. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

15. A telephone call was made to Richard Bridge on March 10, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Art Unit: 1733

Conclusion

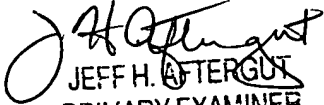
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R Fischer** whose telephone number is **(571) 272-1215**. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Justin Fischer

March 19, 2004


JEFF H. AFTERGUT
PRIMARY EXAMINER
GROUP 1300